

REMARKS

INTRODUCTION

In accordance with the foregoing, claims 4-11, 13, 16, 17, 22-24, 26, 27, 30, and 31 have been amended. Claim 32 has been added. Claims 4-32 are pending and under consideration.

ENTRY OF AMENDMENT UNDER 37 C.F.R. §1.116:

Applicant requests entry of this Rule 116 Response because: the amendments place the application at least into a better form for purposes of appeal.

The Manual of Patent Examining Procedure sets forth in Section 714.12 that "any amendment that would place the case either in condition for allowance or in better form for appeal may be entered." Moreover, Section 714.13 sets forth that "the Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedure further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103

On pages 2 and 3, claims 4-6, 24, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,128,744 (Wang).

The Office Action acknowledges on page 2 that Wang is "silent [with respect] to the system including a display." Wang also fails to teach or suggest, *inter alia*, "a display apparatus capable of showing a display," and "a controller reading the personal identification information via the interface from the smart card, and controlling turning the display of the display apparatus on or off" as recited in independent claim 4, for example.

Although Wang discusses a computer starter, this computer starter does not relate to a display apparatus. Wang describes a non-analogous art of an ATX computer system (abstract). Wang teaches away from the present application of implementing a display apparatus with a display by stating:

However, such a mechanical switch device relies on human hands to turn the computer system on or off, so the computer system can not be turned on or off when no one is present (col. 1, lines 28-31).

Thus, the alleged teachings of Wang rely only on the computer starter for an ATX computer system to turn the computer system on upon insertion of a smart card and block a start

signal from an external panel (col. 2, lines 31-34).

Furthermore, on page 3 of the Office Action, the rejection rationale has set forth that "Re claim 4, Wang teaches a starter for an ATX computer. This is interpreted as a computer, monitor, as it monitor/detects cards inserted for access to a computer system, where it would have been obvious to one of ordinarily skill in the art to include a display."

The Examiner is relying on Wang, which is directed to an ATX computer. It is well known and established in the art that an ATX computer does not have a monitor or a display apparatus.

Thus, the Office Action is setting forth a motivational rationale not supported by the record, but rather based solely on the Examiner's belief of what one skilled in the art may have tried or recognized.

However, to set forth a prima facie §103 rejection, there must be some evidenced reason for modifying a reference. Specifically, there must be evidence, outside of the present application, which motivates, leads, or suggests to one of ordinary skill to modify a reference. In addition, an "obvious to try" rationale for combining two references is not valid motivation under 35 USC §103. In re Goodwin, 576 F.2d 375, 377, 198 USPQ 1, 3 (CCPA 1978); In re Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977); In re Tomlinson, 363 F.2d 928, 150 USPQ 623 (CCPA 1966).

Further, it is well settled that "the Board [and Examiner] cannot simply reach conclusions based on [their] own understanding or experience - or on [their] assessment of what would be basic knowledge or common sense. Rather the Board [and Examiner] must point to some concrete evidence in the record in support of these findings." In re Zurko, 258 F. 3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). See also In re Lee, 277 F. 3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), in which the court required evidence for the determination of unpatentability by clarifying that the principles of "**common knowledge**" and "**common sense**" may only be applied to the analysis of evidence, rather than be a substitute for evidence.

Thus, accordingly, a prima facie obviousness rejection requires evidenced motivation from something in the record that would lead one skilled in the art to combine the relevant teachings, again noting that the mere fact that the prior art may be modified in a particular manner does not make the modification obvious unless the prior art suggested the desirability of that modification.

Contrary to these requirements, the outstanding Office Action merely presents the

proposal that the modification of Wang's ATX computer to include the claimed display of a display apparatus, which the Office Action has interpreted as being disclosed in Wang, and concludes the obviousness of the same, without providing support in the record for motivation of the same.

Such motivational conclusions are improper. The relied upon motivation must be evidenced in the record, and cannot be based merely on an opinion of the Examiner.

Accordingly, it is respectfully requested that the next Office Action following the above guidelines and present a new non-final Office Action, if necessary, presenting rejections based on the same.

On pages 3 and 4, claims 7-8 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang, in view of Huang et al. (U.S. Patent Publication No. 2003/0126483 – hereinafter Huang).

The Applicant would like to clarify the status of claim 22. Claim 22 was allowed in the Office Action Summary (box 5) and on page 9 of the Office Action. Additionally, reasons for allowance for claim 22 are provided on page 9. Thus the rejection on pages 3 and 4, should state: claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang, in view of Huang.

On page 4, the Office Action states that "Wang is silent to registering/storing the card information." The Office Action relies on Huang to cure the deficiencies of Wang. As stated above, Wang is directed to a non-analogous art of an ATX computer. Wang fails to teach or suggest, "...controlling whether the display of the display apparatus is on or off when the insertion of the smart card is detected" as recited in amended, independent claim 4 from which claims 7 and 8 depend.

Similar to Wang, Huang is directed to an ATX computer, and therefore does not teach or suggest "...controlling turning the display of the display apparatus on or off when the insertion of the smart card is detected" as recited in amended, independent claim 4.

Thus, Huang cannot be relied upon to cure the deficiencies of Wang.

On page 4, claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wang, in view of Huang et al., and further in view of U.S. Patent No. 5,327,497 (Mooney et al.)

As discussed above, Wang and Huang are directed to a non-analogous art of an ATX computer, which does not have a display apparatus.

Mooney discusses in col. 5, line 68 – col. 6, line 6:

If the value of the retry counter is less than the maximum allowed value, control returns to 225, otherwise at 237 the secure computer electrically erases RAM 127 and initiates the physical destruction of the hard disk 164 via line 165 if authorized by the security administrator, then reboots the computer.

Mooney fails to teach or suggest, “wherein during the deleting, the personal identification information is deleted from the storage unit of the display apparatus” as recited in amended, claim 9.

On page 5, claims 10-12, 26, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang, in view of Bilich (U.S. Patent No. 5,877,483 – hereinafter Bilich)

The Office Action states on page 5:

For purposes of Examination, the Examiner has interpreted a computer starter as a computer monitor as it controls the powering/operation of the computer monitor connected to a system (computer system), as discussed above including a display.

As stated above, a computer starter, specifically in an ATX computer, is not a display apparatus. A computer starter in the cited references does not have a monitor or display. For example, claim 11 recites, “turning the display shown on the display apparatus on.” Thus, the display of claim 11 must be tangible and visible to the user. None of the cited references are capable of performing the intended use of the claimed display (see, In re Casey, 152 USPQ 235 (CCPA 1967), In re Otto, 136 USPQ 458, 459 (CCPA 1963), and MPEP 707.07).

On page 8 of the Office Action, the Examiner repeats the obviousness rationale for combining Wang and Bilich by stating:

The Examiner has interpreted the card accepting device as a computer monitor, which is taught as being part of a computer system, which typically would include a display means to be interfaced with by a user, as convention in the art. With this interpretation, the card is still being inserted into the monitor itself.

In Fig. 1, Bilich shows the card reader 16 that is separate from the CPU 14. Bilich describes the computer 10 having separate parts, such as a power supply 12, a CPU 14, memory 15, a card reader 16, and various I/O devices 17 (col. 3, lines 8-17). Bilich states that “[the] data encoded on the card, in particular, the user ID and security codes, is read by the card reader 16 and transmitted to the CPU 14” (*emphasis added*, col. 4, lines 1-3).

Thus, the card reader 16 of Bilich is not part of the CPU 14.

Therefore, Bilich does not teach or suggest "...turning the display of the display apparatus off when the smart card is not inserted into the display apparatus, after a predetermined time; reading personal identification information from the smart card when the smart card is inserted into the display apparatus" as recited, for example, in independent claim 26.

Thus, Bilich cannot be relied upon to cure the deficiencies of Wang.

On page 6, claims 13-15 and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang, in view of Bilich, and further in view of Huang.

Claims 13-15 that depend from claim 11 and claims 27-29 that depend from claim 26 include all of the features of their respective base claim plus additional features, which are not taught or suggested by the cited references. Therefore, for at least these reasons, it is respectfully submitted that claims 13-15 and 27-29 also patentably distinguish over the cited references.

In view of the above, it is respectfully submitted that the rejection is overcome.

On pages 6 and 7, claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Huang et al.

As stated above, Huang is directed to an ATX computer, which does not include a display or a display apparatus. Therefore, Huang does not teach or suggest, *inter alia*, "...checking the insertion of the smart card into the display apparatus through a smart card interface on the display apparatus; and turning the display of the display apparatus on when the insertion of the smart card is detected" as recited in independent claim 16.

Withdrawal of the rejection is respectfully requested.

On page 7, claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Huang et al., in view of Mooney et al.

Nothing was cited or has been found in Mooney suggesting modifications of Huang to overcome the deficiencies discussed above.

Withdrawal of the rejection is respectfully requested.

On pages 7 and 8, claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wang, in view of Bilich et al., and further in view of Mooney et al.

Claim 31 depends from claim 30 and includes all of the features of that claim plus additional features, which are not taught or suggested by the cited references. Therefore, for at least these reasons, it is respectfully submitted that claim 31 also patentably distinguishes over the cited references.

In view of the above, it is respectfully submitted that the rejection is overcome.

ALLOWABLE SUBJECT MATTER

On page 9, claims 18-22 are allowed.

NEW CLAIM

New claim 32 recites "...wherein the monitor displays a warning using the OSD region based upon the authentication result when the personal identification information does not relate to an authenticated user." Nothing in the cited references teaches or suggests such. It is submitted that this new claim, which is different and not narrower than prior filed claims distinguishes over the cited references.

CONCLUSION:

In accordance with the foregoing, Applicant respectfully submits that all outstanding objections and rejections have been overcome and/or rendered moot, and further, that all pending claims patentably distinguish over the cited art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited. At a minimum, the Board should enter this Amendment at least for purposes of Appeal as it either clarifies and/or narrows the issues for consideration.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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11/13/04

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